



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: John Werner Bulluck and Brad Rix

Filed: June 14, 2001

For: ROOM TEMPERATURE CURED HIGH TEMPERATURE AND LOAD
DIMENSIONALLY STABLE ACRYLATE ADHESIVES

Serial No.: 09/881,587

Group Art Unit: 1712

Examiner: SELLERS, ROBERT E.

Atty Dkt: TRIA:002

Pursuant to 37 C.F.R. 1.8, I certify that this correspondence is being deposited with the U.S. Postal Service in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on the date below:

October 17, 2002 *Robert E. Sellers*
Date Name

Assistant Commissioner For Patents
Washington, D.C. 20231

Dear Sir:

RESPONSE TO RESTRICTION REQUIREMENT

Applicant submits this paper in response to the office action mailed September 17, 2002.

In the office action, the examiner entered a restriction requirement as follows:

- Group I: claims 1-6 and 8-15,
- Group II: claim 7,
- Group III: claims 16-23,
- Group IV: claims 24-31,
- Group V: claims 32-48,
- Group VI: claims 39-44 and 46-52,
- Group VII: claim 45,

Group VIII: claims 53-58 and 60-66,

Group IX: claim 59,

Group X: claims 67-73,

Group XI: claims 74-80, and

Group XII: claims 81-87.

In response, Applicant elects to prosecute Group I, claims 1-6 and 8-15, with traverse. Please withdraw Groups III-XII from further consideration at this time.

Groups I and II were improperly restricted. Reconsideration is therefore requested for the following reasons. In the first instance, the examiner asserted that Groups I and II were in an "intermediate-final" product relationship. This is not correct. Group II is simply the two-part system of claim 1 *further comprising* the recitations of Group II. Claim 7 (Group II) is thus intended to be an alternative embodiment of the Group I invention, prior to application of the adhesive system. This is not an "intermediate-final" product relationship. Groups I and II are both used as adhesives, and the examiner has not provided an example of an alternative use as required by MPEP 806.04(b), cited by the examiner.

Secondly, the examiner asserted that their different classifications showed their separate status in the art. This too is in error. In the first instance, both Groups I and II correspond to class 252, *differing only in subclass 183.11 and 183.12*. This hardly justifies either a finding of undue burden in searching or distinctness in the art.

Furthermore, MPEP 806.04(a) states that a reasonable number of species may still be claimed in one application. Assuming Groups I and II are species, the addition of a single claim (claim 7) into Group I is certainly a reasonable number.

In view of the foregoing, it is respectfully requested that the restriction between Groups I and II be withdrawn, and claim 7 be examined.

In addition, Groups VI and VII were restricted for essentially the same rationale as Groups I and II. This was also in error. Reconsideration is therefore requested for the following reasons. In the first instance, the examiner asserted that Groups VI and VII were distinct because the "additional reactive component in Part A of Group VII confers materially different properties from the two part adhesive of Group VI. The examiner provides absolutely no basis for this assertion. Again, Group VI is simply the two-part system of claim VII *further comprising* the recitations of Group VII. Group VII is thus intended to be an alternative embodiment of the Group VI invention, prior to application of the adhesive system. This is not an "intermediate-final" product relationship as asserted for Groups I and II. Groups VI and VII are both used as adhesives, and the examiner has not provided an example of an alternative use as required by MPEP 806.04(b), cited by the examiner.

Secondly, the examiner asserted that their different classifications showed their separate status in the art. This too is in error. In the first instance, both Groups I and II correspond to class 156, *differing only in subclass 306.3 and 326*. This hardly justifies either a finding of undue burden in searching or distinctness in the art.

Furthermore, MPEP 806.04(a) states that a reasonable number of species may still be claimed in one application. Assuming Groups VI and VII are species, the addition of a single claim (Group VII) into Group VI is certainly a reasonable number.

In view of the foregoing, it is respectfully requested that the restriction between Groups VI and VII be withdrawn.

Also, Groups VIII and IX were restricted for essentially the same rationale as Groups VI and VII. This was in error. Reconsideration is therefore requested for the following reasons. In the first instance, the examiner asserted that Groups VIII and IX were distinct because the different reactive constituents imparted materially diverse characteristics to the fiber set with the cured adhesive. The examiner provides absolutely no basis for this assertion. Again, Group IX is simply the two-part system of claim VIII *further comprising* the recitations of Group IX.

Group IX is thus intended to be an alternative embodiment of the Group VIII invention. This is not an "intermediate-final" product relationship as asserted for Groups I and II. Groups VIII and IX are both used as adhesives, and the examiner has not provided an example of an alternative use as required by MPEP 806.04(b), cited by the examiner.

Secondly, the examiner asserted that their different classifications showed their separate status in the art. This too is in error. In the first instance, both Groups VI and VII correspond to class 156, *differing only in subclass 157 and 158*. This hardly justifies either a finding of undue burden in searching or distinctness in the art.

Furthermore, MPEP 806.04(a) states that a reasonable number of species may still be claimed in one application. Assuming Groups VIII and IX are species, the addition of a single claim (Group IX) into Group VIII is certainly a reasonable number.

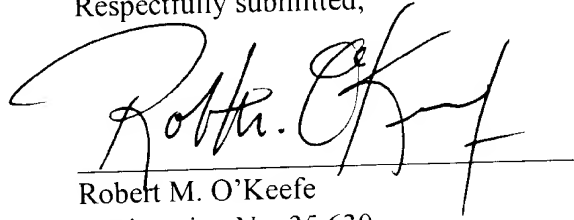
In view of the foregoing, it is respectfully requested that the restriction between Groups VIII and IX be withdrawn.

In the cases discussed above, the examiner has simply not met the burden required for a restriction. It is for this reason that the restrictions were improper.

Next, the examiner called for an election of species from species 1) through 6) identified at page 6 of the office action. Rule 146 provides for election of a species to which the claim(s) will be restricted if no claim to the genus is found to be allowable. In this case, pursuant to Rule 146, Applicant elects ethylene glycol dimethacrylate for species 1), benzoquinone for species 2), N,N-dimethyl-p-toluidine for species 3), and ethylene glycol dimethacrylate for species 4). Since Group I has been elected under the restriction requirement, there appears to be no need to elect a species for species 5) or 6). Claims 1-6 and 8-15 are all believed to be readable thereon. As indicated in the office action, all claims are generic.

Should any fees under 37 CRF 1.16-1.21 be required for any reason relating to the enclosed materials, the Commissioner is authorized to deduct such fees from O'Keefe, Egan & Peterman Deposit Account No. 10-1205. The examiner is invited to contact the undersigned at the phone number indicated below with any questions or comments, or to otherwise facilitate expeditious and compact prosecution of the application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert M. O'Keefe", written over a horizontal line.

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